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09/580,412	05/30/2000	Henry H. Jenkins	7947	8695

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EXAMINER

FLORES SANCHEZ, OMAR

ART UNIT	PAPER NUMBER
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3724

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12

Application Number: 09/580,412
Filing Date: May 30, 2000
Appellant(s): JENKINS, HENRY H.

Charles R. Rust
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/03/02.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct, except that the rejection of claims 1-6 has been dropped, and is therefore not an issue.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 2-3 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

171,270	A. DEWES	12-1875
5,676,032	JOHNSON	10-1997

5,943,935

BRAYTON ET AL.

8-1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 7-17, 20-22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson. In regards to claim 14-17 and 20-23, Johnson shows all the recited elements and features without modification. This rejection is not considered to be a new issue, since anticipation is within the confines of obviousness. Johnson discloses (Fig. 5-19) the invention including a metal plate (see Fig. 16), a top board 3, a plurality of rule slots 27, a steel rule/metal member 4, a cutting edge is defined by a generally triangular shape configuration (see figure 8), a bottom portion and first and second end portions extending at approximately a 45° angle in a first direction and a second direction. When considering claims 7-13, one must look at Johnson's figures 2A and 20. In these figures Johnson is setting up a base board for retaining a plurality of steel rule dies such as those found in figure 7. It appears that two such dies may be "adjacent" one another. However, if it is interpreted that they are not "adjacent", then it would have been obvious to one of having ordinary skill in the art at the time the invention was made to modified Johnson's steel rules by providing a second adjacent steel rule having first and second end portions extending at approximately a 45° angle, since it may be necessary to create certain cutting configurations and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art, and in order to create the desired shape of cut.

In regards to claims 18, 19, 24 and 25, it is noted that the edges of Johnson steel rule dies are capable of being non-vertical, depending on the orientation of the die press. It is common for the die presses to operate in several different orientations.

(11) Response to Argument

The examiner agrees that the combination of Brayton and Dewes regarding claims 1 and 4-6 is not proper. Also, the combination of Brayton and Johnson regarding claims 2-3 is not proper. For the above reasons, the rejections are withdrawn and claims 1-6 are allowable over the prior art.

Appellant argues that Johnson lacks "a single rule", "a second adjacent steel rule", "a given steel rule engages the next adjacent steel rule to form a 45 degree corner" and "the ends of the rule extends at 45 degree angle and they extend on different side of the axis". The examiner disagrees for the following reasons. First, it should be noted by the board that independent claims 7, 11, 14 and 20 do not have the above-recited limitation, but rather recites, *inter-alia*, "a steel rule" and "approximately 45 degree angle".

It is noted that Appellant's claims have not precluded that the steel rule die is made of plural pieces permanently joined together. In the art when two steel rules are joined by a variety of techniques such as welding, silver soldering, brazing, riveting, or a combination of these (see Johnson's column 8, lines 17-19), the two steel rules are considered to represent a single steel rule. The second argument above a given steel rule engages the next adjacent steel rule to form a 45 degree corner are not at a 45

degree corner but rather at approximately a 45 degree corner by the recitation of claims that the ends of the rule extends at approximately a 45 degree angle. Therefore, the examiner can only conclude that the above phrase merely requires being close to 45° but not exactly 45°.

Now turning to the applied art, Johnson, the examiner will explain how Johnson reads on the above phrases. Johnson discloses a steel rule 4 having a first end portion 9 and a second end portion located at the left side of the first end portion (see Fig. 9-10). Additionally, it should be noted that both ends have bent portions that are at opposite side of the longitudinal axis of the steel rule. Also, both ends extend at approximately 45° angle to the longitudinal axis. Figure 2A illustrates various ends portions engaging others steel rules to form approximately 45° angle corner.

Appellant notes that Johnson, in figure 7, has 4 bent ends, whereas Appellant's dice has only two bent ends. However, nothing in Appellant's claims preclude the existence of additional bent ends. Some of the Appellant's claims say the die is "generally flat", since the claims also indicate that the die is significantly bent, the term "generally flat" is given a somewhat broader interpretation than normal. The interpretation that best fits the situation is that "generally flat" means that the rule is flat within a given portion. It is noted that Johnson's die of figure 7 is flat within any given portion.

Appellant argues claims 18, 19, 24 and 25, stating that the ends of Johnson's die are vertical, as opposed to being angled from the vertical. However, the orientation of the dies has no significant on its operation. However, if these claims are interpreted to

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mean that the terminal ends of the dies are oblique to the cutting edge, then a different rejection would need to be applied.

For the above reasons, it is believed that the rejection should be sustained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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October 21, 2002

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